REMARKS

Claims 1-18 are pending in the present application, and claims 1-18 were rejected in the Office Action dated November 23, 2005. In this Amendment, claim 1 is amended and no claims are added or canceled. No new matter has been added.

I. 35 U.S.C. § 103 Obviousness Rejection of Claims

Claims 1-4 and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horie et al. (US Patent 6,487,597, hereinafter "*Horie*") in view of *Schlafly* (US Patent 5,471,612). Applicants respectfully traverse this rejection.

Previously, Applicants argued that the combination of *Horie* and *Schlafly* fails to teach or suggest evaluating formulas **while** converting the spreadsheet file. In response, the Examiner contends that the combination of *Horie* and *Schlafly* meets the limitations of claim 1, without citing to any portion of *Horie* or *Schlafly* that teaches or suggests formulas **while** converting a spreadsheet file. The Examiner is incorrect. The combined references must teach or suggest every limitation of the claims. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The combined references fail to teach the contemporaneous evaluation of formulas and conversion of a spreadsheet file, as required by the word "while" in the claim. Moreover, it would not have been obvious to perform these acts contemporaneously to solve the problem at hand, as evidenced, for example, by the long-felt need described in the patent application. See page 8, ll. 6-14 of the patent application. Accordingly, the combination of *Horie* and *Schlafly* fails to teach or suggest every limitation of the claims, and *prima facie* obviousness has not been established.

Furthermore, Applicants respectfully submit there is no motivation to combine *Horie* and *Schlafly*. "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). However, *Horie* in no way discusses formulas, and *Schlafly* in no way discusses transferring spreadsheet files to a device. Thus, there is no motivation to combine the references found within the references themselves, as one of ordinary skill in the art with the references before him would not be sufficiently enabled to combine the references as proposed by the Examiner.

Moreover, motivation would not be found in the knowledge of one of ordinary skill in the art, as evidenced by the long-felt need for methods and systems consistent with the present invention discussed above. Neither *Horie* nor *Schlafly* addresses the nature of a problem solved by embodiments consistent with the present invention, namely the reduction of memory required by a spreadsheet file when transferred to a device such as a PDA. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Thus, one of ordinary skill in the art would not be motivated to modify *Horie* with *Schlafly* as proposed by the Examiner.

Still further, the Examiner contends that the motivation to combine is found in the increased speed of transmission of the spreadsheet from the personal computer to the PDA. This contention is illogical, however, as the evaluation of formulas during conversion and transmission would require more computation and add more data to the file being transmitted, thus slowing the speed of transmission. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

MPEP 2143.01 (Emphasis original), *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). *Horie* fails to provide the requisite desirability for the proposed modification.

Claim 10 is not unpatentable over *Horie* in view of *Schlafly* for at least the same reasons that claim 1 is not unpatentable over *Horie* in view of *Schlafly*. Claims 2-4 and 11-13 depend upon claims 1 and 10 respectively and are also therefore not unpatentable.

Claims 5-9 and 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Horie* in view of *Schlafly*, and further in view of *Pajokowski* et al. (US Patent 6,718,425). Applicants respectfully traverse the rejection to the claims. The rejection of claims 5-9 and 14-18 relies on the propriety of the rejection of claims 1 and 10, respectively. As previously explained, those rejections are erroneous.

II. Conclusion

In view of the above remarks, Applicants submit that all claims are allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

Dated: February 23, 2006

By: _____
A. Wesley Ferrebee
Registration No. 51,312

Customer No.: 58328
SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
Phone: (202) 408-9214
Fax: (312) 876-7457